REMARKS/ARGUMENTS

Present Invention and Pending Claims

The present invention relates to an adhesive composition for application to skin. Claims 1, 4, 6-9, 12, and 14-16 are pending.

Amendments to the Claims

The claims have been amended so as to more particularly point out and distinctly claim the subject matter. In particular, the term "glycerine" of dependant claims 6 and 14 has been replaced with "triglycerine" to establish proper antecedent basis with independent claims 1 and 9, respectively. Accordingly, no new matter has been added by way of these amendments.

Summary of the Office Action

The Examiner has rejected claims 6 and 14 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Claims 1, 4, 6-9, 12, and 14-16 have been rejected for obviousness-type double patenting over claims 1 and 10-14 of U.S. Patent No. 6,787,681 (Murakami et al., hereinafter "the '681 patent"). Additionally, claims 1, 4, 6-9, 12, and 14-16 have been provisionally rejected for obviousness-type double patenting over claims 1, 4, 5, and 10 of copending U.S. Patent Application No. 10/443,844 (Murakami et al., U.S. Patent Application Publication No. 2003/0224160, hereinafter "the '844 application"). Reconsideration of the pending claims is respectfully requested.

Discussion of the Indefiniteness Rejection

The Examiner has rejected claims 6 and 14 as allegedly containing indefinite subject matter due to allegedly improper antecedent basis for the term "glycerine." Applicants have amended claims 6 and 14, consistent with the Examiner's suggestion, and replaced the term "glycerine" with the term "triglycerine" so as to avoid any confusion. Accordingly, the indefiniteness rejection under section 112 has been rendered moot.

Discussion of the Non-Provisional Obviousness-Type Double Patenting Rejection

Claims 1, 4, 6-9, 12, and 14-16 have been rejected for obviousness-type double patenting over claims 1 and 10-14 of the Murakami '681 patent. Applicants submit and

enclose herewith a terminal disclaimer for the present application and the '681 patent. In view of the terminal disclaimer, the obviousness-type double patenting rejection should be withdrawn.

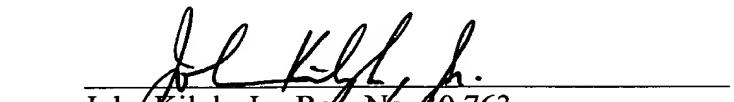
Discussion of the Provisional Obviousness-Type Double Patenting Rejection

The obviousness-type double patenting rejection with respect to the '844 application is provisional because the '844 application has not yet issued as a patent. As stated in M.P.E.P. § 1504.06, "[i]f a provisional double patenting rejection (of any type) is the only rejection remaining in two conflicting applications, the examiner should withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent." The present application has a filing date of August 29, 2001, whereas the '844 application has a filing date of May 23, 2003. Thus, since the aforementioned rejections have been overcome, the present application should be passed to issuance without the need to address the obviousness-type double patenting rejection. If appropriate, an obviousness-type double patenting rejection may be raised in the prosecution of the '844 application. In such an event, applicants will address the obviousness-type double patenting rejection at that time in connection with the prosecution of the '844 application.

Conclusion

The present application is believed to be in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



John Kilyk, Jr., Reg. No. 30,763
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: May 19, 2005